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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,737	08/08/2001	Yoichiro Mori	52433/652	2910

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EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/924,737

Applicant(s)

MORI ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 12-14 and 16-42 is/are pending in the application.
- 4a) Of the above claim(s) 12, 14, 16-21, 32, 33 and 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13, 22-31 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, 12-14, and 22-39 drawn to a soluble lubricating surface-treated stainless steel, classified in class 428, subclass 544.
  - II. Claims 16-21 and 40-42, drawn to a method of manufacturing a fuel tank, classified in class 228, subclass 141.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II represent separate and patentably distinct inventions. The method for making the fuel tank in group II is separate from the stainless steel in group I because there is no material limitation in group I specifying that the stainless steel is a fuel tank.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Claims 1-3 are generic to a plurality of disclosed patentably distinct species comprising an austenite-type stainless steel sheet, a ferrite-type stainless steel sheet, and a two-phase-type stainless steel sheet. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During telephone conversations with Mr. John Kelly on November 7, 2002 and December 23, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-3, 12-14, and 22-39 and the ferrite-type stainless steel sheet species. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12, 14, 16-21, 32-33, and 37-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 13 and 24-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 13 depends from a cancelled claim (claim 10). For the purposes of examination, this claim was examined as if it included the limitations of original claim 10.
11. Claims 24-25 recite the limitation "the neutralizer" in line 2. There is insufficient antecedent basis for this limitation in the claim.
12. The term "main component" in claims 16-29 is a relative term which renders the claim indefinite. The term "main component" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the

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invention. For the purposes of examination these claims will be interpreted to mean that the polyurethane resin comprises the claimed materials.

### ***Claim Interpretation***

13. Claims 2-3 include the transitional phrase, "mainly comprising" which the examiner interprets to be equivalent to the phrase, "comprising." The examiner bases this interpretation on the specification, which includes numerous additional materials that may be used in the present composition in addition to those the applicant claims. Specific examples are surfactants (page 14 of the specification), neutralizers (page 14 of the specification), and numerous additives (page 15, lines 11-14 of the specification).

14. Claims 22-23 include the limitation that "the resin film is from 30 to 180 in terms of an acid value." The examiner interprets this to mean that the resin film has an acid value of from 30 to 180. The examiner bases this interpretation on commonly used phraseology in the art.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 1-3, 13, 22-23, 26-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsushi et al. in view of Hirata et al.

A translation of Katsushi et al. is included with this office action. Katsushi et al. discloses a lubricating coating on a steel plate. The coating is a polyurethane (PU) that includes polyolefin wax (meeting claims 31-31) and silica in the amounts the applicant claims in claims 2 and 3 (paragraph 5). The polyurethane also has the acid value the applicant claims in claims 22-23 (paragraph 20) and is made from polyester or polyether polyols (paragraph 17), meeting that part of claims 26-29. Due to the crosslinked nature of the PU in Katsushi et al. (paragraph 13), glass transition temperature the applicant claims in claims 2 and 3 is assumed to be inherently present in the reference. Katsushi et al. does not, however, include the specific composition of steel that the applicant claims in claims 13 and 34-36. Hirata et al. contains these parts of the invention.

Hirata et al. discloses a ferritic stainless steel sheet meeting the applicant's compositional requirements of claims 13 and 34-36 (column 8, lines 15-24). Hirata et al. teaches that steel with these compositions have excellent formability (see the abstract).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the steel composition taught in Hirata et al. in the invention in Katsushi et al. The motivation for doing so would be to create a lubricated steel with good formability. Therefore it would have been obvious to combine Hirata et al. with Katsushi et al. to obtain the invention as specified in claims 1-3, 13, 22-23, 26-31, and 34-36.

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17. Claims 1-3, 22-23, 26-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsushi et al. in view of Bohnke et al.

Katsushi et al. discloses a lubricating coating on a steel plate. The coating is a polyurethane (PU) that includes polyolefin wax (meeting claims 31-31) and silica in the amounts the applicant claims in claims 2 and 3 (paragraph 5). The polyurethane also has the acid value the applicant claims in claims 22-23 (paragraph 20) and is made from polyester or polyether polyols (paragraph 17), meeting that part of claims 26-29. Due to the crosslinked nature of the PU in Katsushi et al. (paragraph 13), glass transition temperature the applicant claims in claims 2 and 3 is assumed to be inherently present in the reference. Katsushi et al. does not, however, include the specific composition of steel that the applicant claims in claims 34-36. Bohnke et al. contains these parts of the invention.

Bohnke et al. discloses the metal composition in claims 34-36 (see the abstract) and teaches that steel with this composition has improved heat resistance and creep properties.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the steel composition taught in Bohnke et al. in the invention in Katsushi et al. The motivation for doing so would be to create a lubricated steel with heat resistance and creep properties. Therefore it would have been obvious to combine Bohnke et al. with Katsushi et al. to obtain the invention as specified in claims 1-3, 22-23, 26-31, and 34-36.



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18. Claims 1-3, 13, 22-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryoji et al. in view of Hirata et al.

A translation of Ryoji et al. is included with this office action. Ryoji et al. discloses a PU lubricating film that includes polyolefin wax (meeting claims 30-31) and silica particles in the weight ratios of claims 2 and 3. The carboxyl group content (paragraph 16) in the PU is the same as in claims 22-23, and though the reference does not teach the exact neutralizing agents of claims 24-25 it teaches that an alkali can be used and one skilled in the art would know to neutralize a carboxyl group using an alkali such as potassium or sodium hydroxide. The PU coating is made from polyester or polyether polyols (paragraph 14), meeting that part of claims 26-29 as well. The PU coating is crosslinked (paragraph 9), which leads the examiner to believe that the glass transition temperature in claims 2 and 3 are inherently present in the invention in Ryoji et al. Ryoji et al. does not, however, state that the steel the composition is coated on has the composition that the applicant claims in claims 13 and 34-36. Hirata et al. contains these parts of the invention.

Hirata et al. discloses a ferritic stainless steel sheet meeting the applicant's compositional requirements of claims 13 and 34-36 (column 8, lines 15-24). Hirata et al. teaches that steel with these compositions have excellent formability (see the abstract).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the steel composition taught in Hirata et al. in the invention in Ryoji

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et al. The motivation for doing so would be to create a lubricated steel with good formability. Therefore it would have been obvious to combine Hirata et al. with Ryoji et al. to obtain the invention as specified in claims 1-3, 13, 22-31, and 34-36.

19. Claims 1-3, 22-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryoji et al. in view of Bohnke et al.

Ryoji et al. discloses a PU lubricating film that includes polyolefin wax (meeting claims 30-31) and silica particles in the weight ratios of claims 2 and 3. The carboxyl group content (paragraph 16) in the PU is the same as in claims 22-23, and though the reference does not teach the exact neutralizing agents of claims 24-25 it teaches that an alkali can be used and one skilled in the art would know to neutralize a carboxyl group using an alkali such as potassium or sodium hydroxide. The PU coating is made from polyester or polyether polyols (paragraph 14), meeting that part of claims 26-29 as well. The PU coating is crosslinked (paragraph 9), which leads the examiner to believe that the glass transition temperature in claims 2 and 3 are inherently present in the invention in Ryoji et al. Ryoji et al. does not, however, state that the steel the composition is coated on has the composition that the applicant claims in claims 34-36. Bohnke et al. contains these parts of the invention.

Bohnke et al. discloses the metal composition in claims 34-36 (see the abstract) and teaches that steel with this composition has improved heat resistance and creep properties.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the steel composition taught in Bohnke et al. in the invention in Ryoji et al. The motivation for doing so would be to create a lubricated steel with heat resistance and creep properties. Therefore it would have been obvious to combine Bohnke et al. with Ryoji et al. to obtain the invention as specified in claims 1-3, 22-31, and 34-36.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
December 25, 2002

James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700